



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,586	11/22/2000	Bernard Bendiner	5565x4	1239

7590

04/06/2004

Laff Whitesel & Saret Ltd
401 North Michigan Avenue Suite 1700
Chicago, IL 60611

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
----------	--------------

1615

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,586

Applicant(s)

BENDINER, BERNARD

Examiner

JYOTHSNA A VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Reissue Applications

1. Claims 1-37 are rejected under 35 U.S.C. 251 as defective reissue. Applicants have cancelled all added claims and as there are no other amendments to the specification or claims this reissue has no errors being corrected. Further the reissue declaration does not identify an error being corrected (the error specified related to the added claims which have been canceled) and is therefore defective. **As no error is corrected this reissue is an improper reissue application.**

DETAILED ACTION

The amendment after final cancelled claims 38-59. Claims 1-37 are pending in the application and the status of the application is as follows:

Upon further review of the claims, the finality of the rejection of the last office action is withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-21, and 26-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following enumerated reasons apply:

1. Claims 10-21 and 26-37 lack clarity for the expression "cellulose pulp a water-soluble non-ionic emulsifier that meets the following emulsion stability standards is used: "

Recourse to the specification does not define the standard. Is the emulsifier added to the cellulose pulp?

2. Claims 14-17, and 30-33 would read better by deleting” inclusive “ after 7-8.
3. Claims 18-21 and 34-37-lack clarity. There is no fatty acid amide in the ethoxylated alkyl phenols.
4. Claims 26-37 lack antecedent basis with respect to “ wherein the process”. The claim 22 is drawn to the product.

Claim Rejections - 35 USC § 103

1. Claims 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,822,178(‘178) and 3,655,400(‘400).

The instant application is claiming a preservative for organic matter comprising” a filtrate of a decomposition resistant hydrous cellulose pulp material

2. Potassium sorbate
3. Citric acid
4. Non-ionic emulsifier

The patent ‘178 teaches process for repulping waxed paper using non-ionic emulsifier where in the paper comprises wax and cellulose as claimed and passing it through very fine filter. See the claims. The difference between the patent and the instant application is that the patent does not disclose adding citric acid to lower the PH and adding potassium sorbate to the product. One of ordinary skill in the art with a scientific knowledge would add a weak acid like citric acid so that PH is 6.5 or lower. The patent ‘400 is cited to show that in order to have shelf or product stability potassium sorbate is added. See col.1, last paragraph.

Accordingly it would have been obvious to one of ordinary skill in the art, at the time the invention was made to prepare the product of '178 and add potassium sorbate and add citric acid. The motivation to add potassium sorbate stems the teachings of patent '400 that this compound prevents mold development and shelf instability. One of ordinary skill in the art having scientific knowledge would add weak acid like citric acid to lower the Ph. One of ordinary skill in the art would have reasonable amount of success by taking the product of '178 and adding potassium sorbate so that the product can be used as a preservative and decomposition resistant product because potassium sorbate when added has the advantage of preventing mold development and shelf instability. This is a prima facie case of obviousness.

Allowable Subject Matter

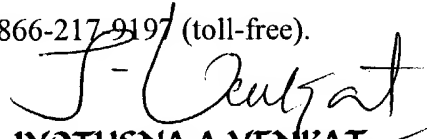
2. Claims 1-9 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615
